

### **REMARKS**

Applicants have thoroughly considered the Examiner's remarks in the August 13, 2008 Office action and have amended the application to more clearly set forth aspects of the invention. This Amendment C amends claims 1, 12, 24, 29 and 36 and cancels claims 11 and 23. No new matter has been added. Claims 1-2, 4-10, 12-17, 19-22, and 24-40 are thus presented in the application for further examination. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

#### **Claim Objections**

Claims 11 and 23 stand objected by the Office for informalities. In further advancing the examination of the application, Applicants have canceled claims 11 and 23. Therefore, the objection to claims 11 and 23 should be withdrawn.

#### **Claim Rejections under 35 U.S.C. §112**

Claims 1, 12, 24, 29 and 36 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that paragraphs [0026-28] provide support for the feature “information indicating the type of the incoming communication from the recipient” (Applicants indicated in the last amendment that paragraph [0026] provides support for the amendment) and paragraphs [0009] and [0063] and FIG. 4B (box 418) provide support for the recited feature “information indicating whether the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit.” Therefore, for at least the reasons above, Applicants respectfully submit the rejection of claims 1, 12, 24, 29 and 36 under 35 U.S.C. §112, first paragraph, should be withdrawn.

Claims 1, 12, 24, 29 and 36 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 1, 12, 24, 29 and 36 to further clarify the claims. Hence, the rejection of claims 1, 12, 24, 29 and 36 under 35 U.S.C. §112, second paragraph, should be withdrawn.

#### **Claim Rejections Under 35 U.S.C. §103**

Claims 1, 2, 4-11, 24-33 and 36-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Pub. No. 2003/0212566 to Fergusson et al. and further in view of US Pub No. 2004/0122730 to Tucciarone and US Pat. No. 5850520 to Griebenow et al. Applicants respectfully submit that the combined references of Fergusson, Tucciarone Griebenow fail to disclose or suggest each and every element of the rejected claims.

Amended claim 1 is clarified to recite, in part:

determining if a last time of a prior communication from the recipient is stored in a data store;

if it is determined that the last time of the prior communication from the client is not stored in the data store, determining if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient;

if the recipient is on the do-not-spam list, terminating sending of the communication to the recipient or sending a separate communication via a compliant channel according to the do-not-spam list;

if it is determined that the last time of the prior communication from the recipient is stored in the data store, which indicates a pre-existing relationship exception to the do-not-spam list may apply, textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient;

if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminating sending of the communication to the recipient or sending the communication via a compliant channel according to the do-not-spam list;

if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-not-spam list and the last time of the prior communication from the client is not stored in the data store:

storing data representing a present time and the identified location corresponding the received incoming communication;

sending the communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and the present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by the anti-spam rules, laws and regulations of the identified location of the recipient for establishing a the preexisting relationship between the recipient and the sender; and

sending information to the recipient in response to the sent communication, said information indicating the following: the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the user to confirm the preexisting business relationship between the recipient and the sender

defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit.

Support for the amendments may be found in at least paragraphs [0031-35] of the application.

Applicants respectfully submit that the Fergusson fails to disclose "textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws, and regulations of the identified location of the recipient" as recited in amended claim 1 because Fergusson merely teaches calling a perspective client if the user is not on the do-not-call list and does not have a pre-existing relationship. Even though Fergusson discloses on paragraph [0091] that the system may obtain other contact information to contact the perspective client that is not prohibited by the do-not-call list, Fergusson teaches away from performing any analysis to the "communication" itself. In other words, Fergusson teaches that "The system may provide the other contact information to the representative, as desired. In some embodiments, the system may help generate a mailing or e-mail, such as with a mail merge function or the like, **that can then be sent to the prospective client.**" In other words, Fergusson fails to perform a holistic approach in compliance with the anti-spam rules, laws and regulations when it attempts to send communications to a perspective client who is on the do-not-call list and does not have a pre-existing relationship. Fergusson performs no analysis whatsoever. To the contrary, the recited features clearly disclose advantages and improvements over the cited art by ensuring the compliance with the anti-spam rules, laws and regulations is both on the timing (e.g., pre-existing relationship) and the content of the communication itself.

Furthermore, Griebenow fails to cure this deficiency. The Office cites that Griebenow sends a renewal notice to a subscriber when a subscription has expired is about to expire. Griebenow, col. 8, lines 35-39. However, it is noted that such renewal notice is sent with a condition, that is the subscription is about to expire or has expired. If the subscription does not expire or is not about to expire, no renewal notice will be sent. As such, without such condition, Griebenow would not send "the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the user to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not

exceed the predetermined time limit". The Office also does not dispute that fact. However, the amended feature of claim 1 is not based on such condition.

Therefore, the combined references of Fergusson, Tucciarone and Griebenow would teach away from embodiments of the invention based on at least the following aspects: 1. there will be no analysis of the communication itself when a perspective client is on the do-not-call list but does not have a pre-existing relationship, and 2. "the stored data indicating the last time that the incoming communication from the recipient is received, the type of the incoming communication from the recipient, and information enabling the user to confirm the preexisting business relationship between the recipient and the sender defined under the anti-spam rules, laws and regulations if the time between the last time of the incoming communication and the present time does not exceed the predetermined time limit" will not be sent to the perspective client unless a subscription is about to expire or has expired.

Therefore, for at least the reasons above, Applicants respectfully submit that the combined references of Fergusson, Tucciarone, and Griebenow fail to disclose or suggest each and every element of the amended claims. Hence, claims 1-2, and 4-11 are patentable over the cited art, and the rejection of claims 1-2 and 4-11 under 35 U.S.C. §103(a) should be withdrawn.

Similarly, claims 24, 29 and 36 recite similar features and limitations that are also patentable over the combined references of Fergusson, Tucciarone, and Griebenow. Hence, the rejection of claims 24-33 and 36-39 under 35 U.S.C. §103(a) should be withdrawn.

Claims 12-19 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson, Tucciarone, Griebenow and further in view of US Pat. Pub. No. 20040128321 to Hamer. Applicants respectfully submit that Hamer fails to cure the deficiencies of Fergusson, Tucciarone, and Griebenow. Amended claim 12 recites features including:

determining if a last time of an earlier communication from the recipient is stored in a data store;

if it is determined that the last time is not stored in the data store, determining if the recipient is on a do-not-spam list according to anti-spam rules, laws and regulations of the identified location of the recipient;

if the recipient is on the do-not-spam list, terminating sending of the communication to the recipient or sending a separate communication via a compliant channel according to the do-not-spam list;

if it is determined that the last time of the prior communication from the recipient is stored in the data store, which indicates a pre-existing relationship

exception to the do-not-spam list may apply, textually analyzing the communication to be sent and determining whether the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient;

if it is determined that the analyzed communication does not comply with the anti-spam rules, laws and regulations of the identified location of the recipient, terminating sending of the communication to the recipient or sending the communication via a compliant channel according to the do-not-spam list;

if it is determined that the analyzed communication complies with the anti-spam rules, laws and regulations of the identified location of the recipient or if the recipient is not on the do-not-spam list and the last time of the prior communication from the client is not stored in the data store:

storing data indicating a present time and the identified location corresponding the received incoming communication....

Therefore, for at least the reasons above, Applicants respectfully submit that amended claim 12 is patentable over Fergusson, Tucciarone, Griebenow and Hamer. Hence, the rejection of claims 12-19 and 13 under 35 U.S.C. §103(a) should be withdrawn.

Claims 20-21 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson, Tucciarone, Griebenow, Hamer, and further in view of US Pub. No. 20040017899 to Garfinkel et al. For at least the reasons above, Applicants respectfully submit that Garfinkel fails to cure the deficiencies of Fergusson, Tucciarone, Griebenow and Hamer. Hence, Applicants respectfully submit that claims 20-21 are patentable over Fergusson, Tucciarone, Griebenow, Hamer, and Garfinkel. Hence, the rejection of claims 20-21 and 34 under 35 U.S.C. §103(a) should be withdrawn.

Claims 22 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson, Tucciarone, Griebenow, Hamer and further in view of US Pat. No. 7155608 to Malik et al. For at least the reasons above, Applicants respectfully submit that the combined references of Fergusson, Tucciarone, Griebenow, Hamer and Malik fail to disclose each and every element of claims 22 and 35. Hence, the rejection of claims 22 and 35 under 35 U.S.C. §103(a) should be withdrawn.

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1-2, 4-10, 12-17, 19-22, and 24-40 as presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

**Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.**

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

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